

**REMARKS**

Applicants acknowledge receipt of the Office Action mailed January 22, 2009.

In the Office Action, the Examiner rejected claims 1-3, 5-12, and 14-19 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda et al.* (U.S. Patent No. 6,785,487) ("*Maeda '487*") in view of *Maeda et al.* (U.S. Patent No. 6,567,627) ("*Maeda '627*"); and rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*, and further in view of *Funaki* (U.S. Patent No. 6,707,471).

In this Amendment, Applicants amend claims 1 and 12, and add new claim 22. Claims 1-3, 5-12, and 14-22 are pending. Of these claims, claims 1 and 12 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 1 and 12, and the addition of new claim 22. No new matter has been introduced.

Based on the foregoing amendments, Applicants traverse the rejections above and respectfully request reconsideration for at least the reasons that follow.

**I. 35 U.S.C. § 103(a) REJECTIONS**

Applicants traverse the rejection of claims 1-3, 5-12, and 14-19 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that amended independent claims 1 and 12 are patentably distinguishable over *Maeda '487* and *Maeda '627* at least for the reasons described below.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Independent claim 1, and similarly independent claim 12, recites an image forming apparatus, comprising: “a setting screen for receiving an input of setting an

image forming condition, . . . wherein the setting screen includes a multi-function OK button for enabling the setting of the image forming condition inputted on the setting screen, the multi-function OK button being configured to perform at least two functions . . . , the at least two functions including . . . creating and displaying a shortcut button for redisplaying the setting screen on which the image forming condition was set," support for which may be found, for example, on page 29, lines 11-14 of the specification (emphasis added).

*Maeda '487* appears to disclose an image forming device arranged such that desired functions and their respective setting details can be allocated to shortcut keys, and titles and icons representing the functions allocated to the shortcut keys can also be designated for the shortcut keys and displayed on the shortcut keys. Accordingly, when executing a function allocated to a shortcut key, the operator can select the desired function according to the indication on the shortcut key without having to refer to the operations manual or the like. (*Maeda '487*, Abstract).

As admitted by the Examiner, *Maeda '487*, however, fails to teach or suggest at least "the setting screen includes a multi[-]function OK button for enabling the setting of the image forming condition inputted on the setting screen, where the multi-function OK button is configured to perform at least two functions when the multi-function OK button receives an input, the at least two functions including enabling the inputted setting of the image forming condition and displaying a shortcut button for redisplaying the setting screen on which the image forming condition was set." (*Office Action*, p. 3, ll. 4-10).

*Maeda* '487 also fails to disclose at least "creating . . . a shortcut button for redisplaying the setting screen on which the image forming condition was set," as recited in claim 1, and similarly claim 12 (emphasis added).

In order to cure the deficiencies of *Maeda* '487, the Examiner relies on *Maeda* '627 and alleges "*Maeda* ('627) discloses . . . [an] apparatus and method for an image forming condition displaying method that . . . discloses a 'close' key that completes the allocation of functions with the settings of function key being 2 in 1, left staple, and dotted line. These settings are confirmed with the creation of a 2 in 1 shortcut (K2) in Figure 16. After selecting the 2 in 1 shortcut, the setting screen 62 is redisplayed." (*Office Action*, p. 3, ll. 10-15). Such teaching, even if present in *Maeda* '627, however, does not constitute or suggest at least "creating . . . a shortcut button for redisplaying the setting screen on which the image forming condition was set," as recited in claim 1 (emphasis added).

*Maeda* '627 discloses allocating a function to a previously-created shortcut button, and does not disclose creating a new shortcut button by depressing an OK button. The "close" key B12 of *Maeda* '627 is a button merely for a name input or name selection, and the function thereof is different from that of the OK button of the present invention.

According to the present invention, when the OK button receives an input after an image forming condition is set on a setting screen, the setting of the image forming condition is enabled, and at the same time, the shortcut button for redisplaying the setting screen on which the image forming condition was set is newly created and displayed. In other words, parallel with enabling the image forming condition, the

shortcut button is automatically created. By using the created shortcut button, a user can rapidly redisplay the setting screen for resetting the image forming condition when the user needs to change/modify the set image forming condition.

As explained above, the elements of independent claims 1 and 12 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claim. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 1 and 12. Claims 1 and 12, and claims 2, 3, 5-11, and 14-19 which depend therefrom, are patentable over *Maeda '487* and *Maeda '627*. Applicants therefore request that the rejection of claims 1-3, 5-12, and 14-19 under 35 U.S.C. § 103(a) be withdrawn.

Applicants traverse the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Maeda '487* in view of *Maeda '627*, and further in view of *Funaki*. The deficiencies of *Maeda '487* and *Maeda '627* are discussed above.

With respect to *Funaki*, the Examiner alleges "Funaki discloses . . . [an] apparatus and method for an image forming condition displaying method that . . . discloses a cancel button for specifying the cancellation of processing of entered data . . ." (*Office Action*, p. 10, ll. 12-14). Such teaching, even if present in *Funaki*, however, does not constitute or suggest at least an image forming apparatus, comprising: "a setting screen for receiving an input of setting an image forming

condition, . . . wherein the setting screen includes a multi-function OK button for enabling the setting of the image forming condition inputted on the setting screen, the multi-function OK button being configured to perform at least two functions . . . , the at least two functions including . . . creating and displaying a shortcut button for redisplaying the setting screen on which the image forming condition was set," as recited in claim 1, and similarly claim 12.

Claims 20 and 21 correspondingly depend from independent claims 1 and 12 and require all elements thereof. As explained above, the elements of independent claims 1 and 12 are neither taught nor suggested by the cited references. Consequently, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claims. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art and a *prima facie* case of obviousness has not been established for claims 20 and 21 at least due to their dependence. Therefore, Applicants request that the rejection of claims 20 and 21 under 35 U.S.C. § 103(a) be withdrawn.

## **II. NEW CLAIM**

New claim 22 depends from claim 1 and is allowable at least for the same reasons claim 1 is allowable. In addition, the dependent claim recites unique combinations that are neither taught nor suggested by the cited art, and therefore is also separately patentable.

### III. CONCLUSION

Applicants respectfully submit that claims 1-3, 5-12, and 14-22 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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